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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/576,050	07/26/2006	Ralf Dunkel	CS8775/BCS033032	9440

34469 7590 07/24/2009  
BAYER CROPSCIENCE LP  
Patent Department  
2 T.W. ALEXANDER DRIVE  
RESEARCH TRIANGLE PARK, NC 27709

EXAMINER
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SAEED, KAMAL A

ART UNIT	PAPER NUMBER
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1626

NOTIFICATION DATE	DELIVERY MODE
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07/24/2009

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

blair.wilson@bayercropscience.com  
pamula.ramsey@bayercropscience.com  
rebecca.hayes@bayercropscience.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/576,050	<b>Applicant(s)</b> DUNKEL ET AL.	
	<b>Examiner</b> Kamal A. Saeed	<b>Art Unit</b> 1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 May 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 13 -18, 20, 21 and 24 is/are pending in the application.
- 4a) Of the above claim(s) 21 and 24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 13-18 and 20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.


### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

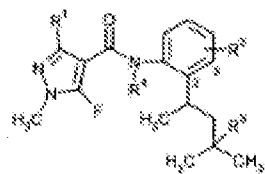
- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>9/18/06</u> .   | 6) <input type="checkbox"/> Other: _____                          |

product of Formula , and the specific compound of Example 6, in response filed May 12, 2009 is acknowledged. Claim 24 is withdrawn from consideration because it doesn't read on the elected species. Applicant's argument in regards to claim 21 has been considered but was found to be not persuasive because the compound claims were found to be not allowable.

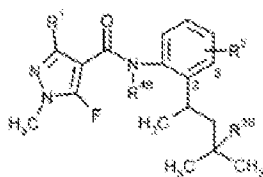
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2. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

**The scope of the invention of the elected subject matter is as follows:**



Compounds of formula I, depicted in claim 13 and



compound of Formula depicted in claim 16, wherein:

**R<sup>1</sup>–R<sup>3</sup>** are as defined; **R<sup>38</sup>** is as defined; **R<sup>4</sup>** and **R<sup>48</sup>** represents alkyl group.

As result of the election and the corresponding scope of the invention identified supra, the remaining subject matter of claims 11, 12, 14 and 17 are withdrawn from further consideration pursuant to 37 CFR 1.142 (b) as being drawn to non-elected inventions. The withdrawn compounds contain varying functional groups such as CN, H, halogen, etc, which are chemically recognized to differ in structure and function from the elected heterocyclic moiety. This recognized chemical diversity of the functional groups can be seen by the various classification of these functional groups in the U.S. classification system, i.e. class 544 subclass 63(+) (thiomorpholine), class 540 subclass

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450(+) (homopiperziny), class 544 subclass 180(+) (triazines), 548 subclass 400(+) pyrrolidines etc. Therefore the subject matter which are withdrawn from consideration as being non-elected subject differ materially in structure and composition and have been restricted properly a reference which anticipated but the elected subject matter would not even render obvious the withdrawn subject matter and the fields of search are not co-extensive.

### **Claim Rejections - 35 USC § 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

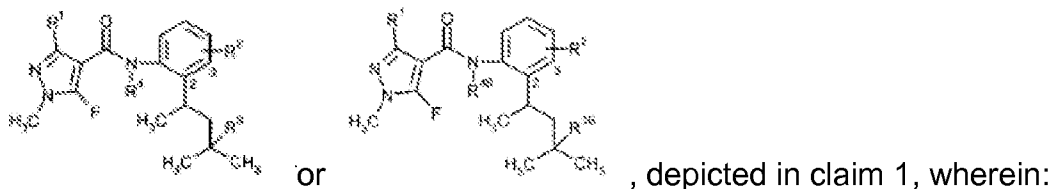
1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. Claims 13 -18 and 20 are rejected as being unpatentable over German

Publication No. DE 10136065 to Elbe et al with a publication date of 02/06/2003 also see corresponding U.S. Patent Application No. US 20040204470.

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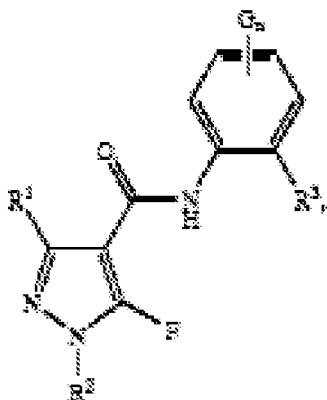
The elected invention is drawn to compounds of formula I,



$R^1$ – $R^3$  are as defined;  $R^{38}$  is as defined;  $R^4$  and  $R^{48}$  represents alkyl group.

Determination of the scope and contents of the prior art

Elbe et al. teaches the compound of compounds of Formula



wherein  $R^1$  is alkyl or haloalkyl;  $R^2$  is alkyl;  $R^3$  is alkyl;  $n$

is zero and  $G$  is absent .

Ascertaining the differences between the instant claims and the prior art

Elbe et al. teach obvious variants of the instantly claimed compounds. The instant claims  $R^4$  and  $R^{48}$  represent alkyl substituents in as opposed to hydrogen of the prior art

Resolving the level of ordinary skill in the pertinent art – Prima facie case of obviousness

MPEP 2144.08.II.A.4(c) states, "...consider teachings of a preferred species within the genus. If such a species is structurally similar to that claimed, its disclosure

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may motivate one of ordinary skill in the art to choose the claimed species or subgenus from the genus, based on the reasonable expectation that structurally similar species usually have similar properties.”

It is sufficient if a reference compound is so closely related to claimed compound that a chemist would find the difference an obvious variation; thus, claims are refused where the difference is primarily the one which exists between a secondary and a tertiary amine. *Ex parte Bluestone*, 135 USPQ 199 (1961).

One of ordinary skill would be motivated, from the exemplified embodiments in the prior art disclosure, to make the modification required to arrive at the instant invention with reasonable expectation of success for obtaining an additional compound for the same utility. The motivation would be to make additional compounds for the same quoted purpose.

### **Double Patenting**

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

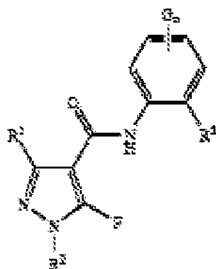
A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to

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be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 13 -18 and 20 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 22-35, 37 and 46 of co-pending U.S. Patent Application No. US 20040204470. Although the conflicting claims are not identical, they are not patentably distinct from each other because the '470



publication disclose compounds of Formula

. MPEP §

2144.08.11.A.4(c) states "... consider teachings of a preferred species within the genus.

If such a species is structurally similar to that claimed, its disclosure may motivate one of ordinary skill in the art to choose the claimed species or subgenus from the genus, based on the reasonable expectation that structurally similar species usually have similar properties". This is the "Genus- Species Guidelines" for examination based on 35 USC 103 and an analogous guideline was followed here for the analysis of obviousness-type double patenting. It is sufficient if a reference compound is so closely related to claimed compound that a chemist would find the difference an obvious variation; thus, claims are refused where the difference is primarily the one which exists between a secondary and a tertiary amine. *Ex parte Bluestone*, 135 USPQ 199 (1961).



Therefore, it would have been obvious to one of ordinary skill in the art to make (at least some of) the compounds and compositions of the instant application given U.S. U.S. Patent Application No. US 20040204470.

### **Claim Objections**

Claims 13 -18 and 20 are objected to for containing non –elected subject matter.

### **Telephone Inquiry**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kamal A Saeed whose telephone number is (571) 272-0705. The examiner can normally be reached on M-T 7:00 AM- 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Joseph K. McKane, can be reached at (571) 272-0699.

Communication via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise requires a signature, may be used by applicant and should be addressed to [joseph.mckane@uspto.gov]. All Internet e-mail communications will be made of record in the application file. PTO employees will not communicate with applicant via Internet e-mail where sensitive data will be exchanged or where there exists a possibility that sensitive data could be identified unless there is of record an express waiver of the confidentiality requirements under 35 U.S.C. 122 by

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the applicant. See the Interim Internet Usage Policy published by the Patent and Trademark Office Official Gazette on February 25, 1997 at 1195 OG 89.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or public PAIR only. For more information about the pair system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197.

/Kamal A Saeed/

Primary Examiner, Art Unit 1626